

Amendments To The Drawings

Replacement sheets for Figs. 6, 7 and 9 accompany this Response. The replacement sheets incorporate the following changes to the figures as originally filed.

Fig. 6

part number 615 changed to 614

part number 625 changed to 624

Fig. 7

part number 716-6 changed to 716-5

part number 716 changed to 718

Fig. 9

added part number 612

part number 715 changed to 718

Remarks

Claim 1-2, 5-8, 11-14 and 17-18 are pending.

Rejections Under 35 U.S.C. § 103

Claims 1 and 5-7, 11-13, 17 and 18 were rejected under Section 103 as being obvious over Biegelsen (6335084), Ueda (5801722) and Brinkman (6598783). Claims 2, 8 and 14 were rejected over Biegelsen, Ueda, Brinkman and Meunier (6582138).

For the reasons detailed below, the Office is urged to reconsider its motivation theory. Applicant respectfully submits that the Office has failed to show that the combination of Biegelsen and Ueda is properly motivated.

Claim 1 recites sensing a media marking on a face of a sheet of print media if the media marking is imprinted on the face of the sheet and sensing a media marking on an edge of a sheet of print media if the media marking is imprinted on the edge of the sheet. Claims 7 and 13 recite similar limitations.

Biegelsen teaches media markings on the edge of the sheets. The Office has interpreted Ueda as teaching media markings on the face of the sheets. Applicant acknowledges in the Background section of the Application that it was known in the art to place markings exclusively on the face of the sheet or on the edge of the sheet.

The Office now asserts two motivations to combine teachings from the prior art to arrive at the claimed invention.

1. Redundancy.

The Office repeats its redundancy motivation. The Office states that the combination would be obvious "to provide redundant means to identify each sheet as being a particular type of image recording media", citing to Biegelsen column 4, lines 63-65. The proffered redundancy motivation fails for two reasons.

First, Biegelsen doesn't say anything about redundancy. The Office's assertion to the contrary is not correct. The cited passage in Biegelsen says only that the "indicia" identifies each sheet as a first type of media. Hence, the Office's proffered motivation to combine Biegelsen and Ueda is not supported in the art. Obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. The Office must rely on objective evidence with respect to the motivation to combine references. MPEP § 2143.01; See, e.g., *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). The Office has not, as yet, provided the required evidence to support its redundancy theory.

Second, redundancy does not motivate the claimed invention. As noted above, the problem with the prior art marking detection systems is not the absence of redundancy, rather it is that printers were designed to read only one type of marking. As noted in the Background section of the Specification, a printer designed to detect a marking on the face of the sheet cannot detect a marking on the edge of the sheet, and a printer designed to detect a marking on the edge of the sheet cannot detect a marking on the face of the sheet. Thus, depending on whether media parameter information is marked on the edge or face of the print media, the printer may not be able to detect any media parameters from marked print media. Accordingly, certain print media are relegated to being properly imaged by a subset of all of the possible imaging devices that may have otherwise been able to form a proper image on the media. Specification, page 3, lines 1-14. Neither Biegelsen nor Ueda recognize this as a problem in the art -- they are the problem in the art. Biegelsen and Ueda do not even contemplate anything other than marking exclusively on the edge (Biegelsen) or on the face (Ueda). Hence, there is no suggestion or motivation in either reference that a printer should be capable of detecting a marking on both the edge and on the face. There is nothing whatsoever in either Biegelsen or Ueda that even remotely suggests a printer that could (or should) have the capability to detect both types of markings.

2. Easily Locating Information.

The Office also asserts the combination of Biegelson and Ueda is motivated by the teachings of Brinkman. The Office states:

"The motivation for doing so would have been to use several duplicate barcode labels to be viewable or able to be scanned from different orientations (Brinkman, col. 6, ln 43-47), to provide a method of marking an object for easily locating information that anyone (or any scanner) can quickly find (Brinkman, col. 2, ln 23-26)" Office Action, page 5.

Brinkman does not teach markings that "any scanner" can find quickly. The relevant passage in Brinkman, at column 2, states that "anyone" can quickly find the information. Hence, Brinkman does not teach all that the Office is relying on for motivation. It is irrelevant to the claimed invention that "anyone" might be able to quickly find information on a parcel, even if that "anyone" is trying to scan a barcode on the parcel. In the claimed invention, by contrast to a human manipulating a parcel to scan the barcode, a scanner/detector in a printer must be able to read the marking on a sheet of paper or other print media. Again, as noted in the Background section of the Specification, the problem with prior art printers is that they are set up to read a marking on the face of the sheet or on the edge of the sheet, but not both. The labeling on the parcels in Brinkman do not suggest anything about devising a printer that can detect a marking on a sheet of paper whether the marking is on the face of the sheet or on the edge of the sheet. That is to say, a printer engineer reading Brinkman would not have the foggiest notion that he could or should solve the pertinent problem in the manner recited in the claims.

As noted above, neither Biegelson nor Ueda recognize the problem -- they are the problem. Hence, it is just not reasonable to suggest a printer engineer would look to Brinkman for a solution to the problem even after considering the teachings of Biegelson and Ueda.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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